



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

mv

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,854	12/31/2001	Corine Vernet	21402-230 (CURA-530)	5243

7590

05/22/2006

Jenell Lawson  
Intellectual Property  
CuraGen Corporation  
555 Long Wharf Drive  
New Haven, CT 06551

EXAMINER

ALLEN, MARIANNE P

ART UNIT

PAPER NUMBER

1647

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/038,854

Applicant(s)

VERNET ET AL.

Examiner

Marianne P. Allen

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 42-47, 49, 50, 52, 55, 57, 59, 61 and 63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 42, 44-47, 49-50 is/are allowed.
- 6) ☒ Claim(s) 43, 52, 55, 57, 59, 61 and 63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's arguments filed 3/14/06 have been fully considered but they are not persuasive.

Claims 42-47, 49-50, 52, 55, 57, 59, 61, and 63 are pending and under consideration by the examiner.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 112***

Claims 43, 52, 55, 57, 59, 61, and 63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Claims 43, 52, 55, 57, 59, 61, and 63 are not originally filed claims.

Claim 43 as amended is directed to a nucleic acid sequence encoding amino acids 337-2721 of SEQ ID NO: 38. However, the specification does not contemplate this subsequence as being part of the intended invention. Applicant has pointed to page 117, lines 12-14; however, this is discussing that "NOV 15b seems to be a Type II (Ncyt Cexo) membrane protein with an INTEGRAL Likelihood of -9.39 for Transmembrane 309-325 (305-377)." This would not readily convey to one of ordinary skill in the art that the subsequence encoding amino acids 337-2721 of SEQ ID NO: 38 was envisioned as being part of the invention.

Claims 52, 55, 57, 59, 61, and 63 are directed to single nucleotide polymorphism coding variants. Basis was stated to be in Table 29. However, this Table is for Nov15a (i.e. SEQ ID NOS: 35 and 36) and not Nov15b (SEQ ID NOS: 37 and 38). The specification does not disclose variants at amino acids residues 27, 39, 76, 220, 236, and 270 for SEQ ID NO: 38. While related, Nov15a and Nov15b do not have the same nucleotide or amino acid sequences as acknowledged by applicant in their response. Applicant's arguments are unpersuasive. The point mutations in question are disclosed with respect to Nov15a and not Nov15b. The specification at page 112 states that "NOV 15 includes four novel TEN-M3-like proteins disclosed below. The disclosed sequences have been named NOV15a, NOV15b, NOV15c, and NOV15d. Unless specifically addressed as NOV15a, NOV15b, NOV15c, or NOV 15d, any reference to NOV15 is assumed to encompass all variants." Anything disclosed with reference to a particular NOV15 cannot be extrapolated to a different NOV15. A fair reading of the disclosure would not readily convey to one of ordinary skill in the art that the single nucleotide polymorphisms disclosed with respect to NOV15a were contemplated as being associated with NOV15b.

### ***Conclusion***

Claims 42, 44-47, 49, and 50 are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

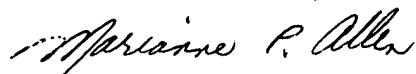
Art Unit: 1647

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 571-272-0712. The examiner can normally be reached on Monday-Thursday, 5:30 am - 1:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Marianne P. Allen  
Primary Examiner  
Art Unit 1647

5/16/06

mpa